PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Dennis G. Earnshaw, et al.	Examiner:	Naresh Vig
Application No.	09/849,513	Group Art Unit:	3629
Filed:	May 5, 2001	Docket No.	70325-040017
Title:	***ELECTRONIC TRANSACTION SERVICE SYSTEM***		
Customer No.:	33717		

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Sherry B. Kolber

AMENDMENT

This paper is responsive to the Final Office Action mailed November 3, 2006.

AMENDMENTS TO THE CLAIMS

Please amend the claims with the following list of claims.

Claim 1 (previously presented): An electronic business transaction service method for conducting a business transaction over a computer network, comprising:

creating on a first computer an electronic business transaction document to be directed to a plurality of recipient parties to a business transaction, the electronic business transaction document being created by a business management software program, the electronic business transaction document including a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, the electronic business transaction document being directed to at least one recipient party in a computer communication format and to at least one other recipient party in a non-computer communication format;

transmitting the electronic business transaction document over the computer network to a network-connected transaction service server computer;

determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction;

if the transaction service server computer determines that the preferred communication format of a recipient party is a computer communication format, sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format; and

if the transaction service server computer determines that the preferred communication format of a party is a non-computer communication format, sending the electronic business transaction document from the transaction service server computer to a second recipient party

using a user preferred non-computer communication format, wherein the user preferred non-computer communication format can be telephonic facsimile or regular mail.

Claim 2 (previously presented): The method of claim 1 in which the preferred communication format includes telephonic facsimile.

Claim 3 (previously presented): The method of claim 1 wherein the preferred communication format includes regular mail, further comprising printing the electronic business transaction document as a printed copy, and mailing the printed copy of the electronic business transaction document to a recipient party.

Claim 4 (previously presented): The method of claim 1 further comprising storing in an electronic address book associated with the business management software program address information for each party and the preferred communication format indicator for each of the plurality of recipient parties of the business transaction indicating the one of the computer and non-computer communication formats in which to transmit communications to the party.

Claim 5 (previously presented): The method of claim 4 wherein adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator.

Claim 6 (previously presented): The method of claim 1 further comprising charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server computer.

Claim 7 (previously presented): The method of claim 1 in which the business management software program is capable of automatically populating and extracting information from the electronic business transaction document, the method further including transmitting a business management software component or access to the business management software component with the electronic business transaction document in the computer format to the at least one recipient party, if it is determined that the at least one recipient party is not capable of viewing the electronic business transaction document, the business management software component not

being capable of automatically populating and extracting information from electronic business transaction documents.

Claim 8 (original): The method of claim 1 in which the electronic business transaction document includes a markup language computer file.

Claim 9 (original): The method of claim 8 in which the markup language computer file includes Extensible Markup Language.

Claim 10 (original): The method of claim 1 in which the business transaction relates to a construction project.

Claim 11-13 (canceled)

Claim 14 (previously presented): In computer readable media, electronic business transaction service software for conducting a business transaction over a computer network, comprising:

software for creating on a first computer an electronic business transaction document to be directed to a plurality of recipient parties to a business transaction, the electronic business transaction document being created by a business management software program, the electronic business transaction document including a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, the electronic business transaction document being directed to at least one recipient party in a computer communication format and to at least one other recipient party in a non-computer communication format;

software for transmitting the electronic business transaction document over the computer network to a network-connected transaction service server computer;

software for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred

communication format indicator of each of the plurality of recipient parties of the business transaction;

software for sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format if the transaction service server computer determines that the preferred communication format of a recipient party is a computer communication format; and

software for sending the electronic business transaction document from the transaction service server computer to a second recipient party using a non-computer communication format if the transaction service server computer determines that the preferred communication format of a party is a non-computer communication format, wherein the non-computer communication format can be telephonic facsimile or regular mail.

Claim 15 (previously presented): The media of claim 14 further software for storing in an electronic address book associated with the business management software program address information for each party and the preferred communication format indicator for each of the plurality of recipient parties of the business transaction indicating the one of the computer and non-computer communication formats in which to transmit communications to the party.

Claim 16 (previously presented): The media of claim 15 wherein adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator.

Claim 17 (previously presented): The media of claim 14 further comprising software for charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server computer.

Claim 18 (original): The media of claim 14 in which the business transaction relates to a construction project.

Claim 19 (currently amended): An electronic business transaction service method for conducting a business transaction over a computer network, comprising:

receiving from a client computer an electronic business transaction document that is compatible with a business management software program, the electronic business transaction document being directed in one or more communication formats to plural recipient parties to a business transaction, the electronic business transaction document being created by a business management software program in the client computer, the electronic business transaction document including address information and a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, the address information and the preferred communication format being automatically retrieved from an electronic address book stored at the client computer, wherein the electronic business transaction document is received by a transaction service server computer communicating with the client computer through a computer network;

determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred business transaction document communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction;

if the transaction service server computer determines that the preferred business transaction document communication format of a party is a computer communication format, sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format; and

if the transaction service server computer determines that the preferred business transaction document communication format of a party is a non-computer communication format, sending the electronic business transaction document from the transaction service server computer to a second recipient party using a non-computer communication format.

Claim 20 (original): The method of claim 19 in which one of the preferred communication formats includes telephonic facsimile.

Claim 21 (canceled)

Claim 22 (previously presented): The method of claim 21 wherein adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator.

Claim 23 (previously presented): The method of claim 22 further comprising manually changing the preferred communication format automatically associated with the recipient party prior to sending the electronic business transaction document to the recipient party.

Claim 24 (previously presented): The method of claim 19 further comprising charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server computer.

REMARKS

Claims 1-10, 14-20, and 22-24 are pending.

Claim 19 has been amended. Amendments to claim 19 have been made to futher define its subject matter.

Claim 21 has been canceled without prejudice or disclaimer.

In the Final Office Action dated November 3, 2006 ("Office Action"), the examiner has made rejections and objections which are hereby addressed as follows. In addition, in the Advisory Action of February 21, 2007, the examiner has deemed amended Claim 19 as "patentably distinct invention from [sic] invention as claimed in claims 1-10 and claim 14-18." In order to clarify this statement, Applicants' representative Pablo Tapia conducted a short telephonic interview with Examiner Naresh Vig on February 20, 2007. During the interview, the Examiner indicated that Claim 19 as amended was patentably distinct from the references cited and/or their combination.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-10, 14-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Henry U.S. Patent No. 6,424,426 ("Henry"), in view of Akimoto, U.S. Patent No. 6,775,711 ("Akimoto"). Applicants traverse the Examiner's rejections for the following reasons.

Applicants submit that the combination of Henry and Akimoto as presented by the examiner does not include all of the limitations of the claims in the instant patent application. First, Henry does not teach a business management software program as disclosed in the present application. Henry discloses tecnology related to the Inernet service MongoNet. MongoNet allows users to manually fill out a form with email addresses and scan such form into a fax machine for transmission to the email addresses provided in the form. It is the user that fills in the email address on the form, not a computer program. In the application disclosed herein, the business management software program adds a communication format to the electronic business transaction document.

Second, the Office Action has cited Akimoto as to cure the deficiency of determining a preferred communication format for each of the plurality of recipient parties of the business transaction. Akimoto teaches nothing on determining preferred communication formats. The Office Action cites Akimoto's Figure 8 and the associated description as teaching a determination of preferred communication formats. Figure 8, and the description of Figure 8, discuss how various identification characters are used to manipulate the content being transmitted. "The mail address analize section 308 sends the analysis result to the determination section 309 [which] determines whether or not encryption processing is performed in later steps based on the analysis result." *See* Akimoto, Column 8, Lines 17-21 (describing of Figure 8). "In other words, when the mail adddress analyze section 308 detetects characters "A" to "C" after the identifirfcation character "@" the determination section 309 determines that processing according with these charactes is executed." *See* Akimoto, Column 8, Lines 30-35 (describing of Figure 8). Figure 7 is brings further understanding to Akimoto's identification characters. Figure 7 shows a column of various identification characters and a column of corresponding content processing operations.

"The identification character/processing table is stored in RAM 209. Here, as identification characters, characters A to C are used in addition to "@", and processing contents are determined in association with these identification characters, respectively. When the identification "A" is added, signature processing is carried out. When the identification "B" is added, encryption processing is carried out. When the identification "C" is added, JPEG conversion is carried out. The JPEG conversion is herein referred to processing for converting the MH file to the JPEG file." *See* Akimoto, Column 7, Lines 25-35 (describing of Figure 7).

The processing referred to in Akimoto (which is triggered by various identificiation characters) is for **content processing**, such as signature processing, encryption processing, JPEG conversion, etc. Therefore, the identification characters in Akimoto are used for formating the actual content that is to be transmitted, and give no indication of a preferred communication channel to be utilized. Therefore, Akimoto does not teach determining a preferred

communication format for each of the plurality of recipient parties, wherein the format can be computer or non-computer communication format.

Furthermore, Applicants challenge the conclusion that the Henry-Akimoto combination teach the limitations of the present application. In particular, the proposed combination renders a different system than the system claimed in the present application. The system of Akimoto, wherein identification characters are used in the destination address in order to provide content manipulation, combined with Henry would add new content functions so as to manipulate content of the fax document being sent. Such identification characters do not, however, work as communication format indicators. As such, Applicants strongly disagree that the Henry in view of Akimoto render claims 1-10, 14-20, and 22-24 obvious.

Therefore, Applicants request that the rejection of Claims 1, 14 and 19 be withdrawn. Further, claims 2-10, 15-18 and 20 depend from independent claims 1, 14 and 19 respectively. Accordingly, Applicants also request that the rejections of these claims also be withdrawn.

In view of the above, it is submitted that this application is now in good order for allowance, and such early action is respectfully requested. Should matters remain that the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicants' undersigned attorney at (310) 586-6512.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to Deposit Account Number 50-2638, Deposit Account Name Greenberg Traurig, LLP. Please ensure that the Attorney Docket Number 70325-040017 is referred to when charging any payments or credits for this case.

Respectfully submitted,

Date: April 3, 2007

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